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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,175	09/03/2003	Michael John Cyr	71306 (US04)	4338

7590 11/10/2004

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EXAMINER

AULAKH, CHARANJIT

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/654,175

Applicant(s)

CYR ET AL.

Examiner

Charanjit S. Aulakh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 10 is/are rejected.
- 7) ☒ Claim(s) 1-4 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: 11/08/04.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### **DETAILED ACTION**

1. According to a preliminary amendment filed on Sep. 3, 2003, the applicants have canceled claims 5, 6, 9 and 11-20 and furthermore, have amended claims 1-3, 7, 8 and 10.
2. Claims 1-4, 7, 8 and 10 are now pending in the application.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 7, 8 and 10, drawn to compounds of formula II where A represents anthraquinone, anthrapyridone or anthrapyridine and a process for preparing these compounds, classified in class 546, subclass 75.
  - II. Claims 1-4, 7, 8 and 10, drawn to compounds of formula II where A is other than defined above for group I and a process for preparing these compounds, classified in class 544, subclass 245.
4. The inventions I and II as defined above are patentably distinct, each from the other since they are structurally so divergent that a reference showing compounds of invention I would not render compounds of invention II prima facie obvious. Search required for e.g ; compounds of invention I in class 546 is not the same search required for e.g ; compounds of invention II in class 544 and therefore, constitutes a burdensome search.
5. During a telephone conversation with the applicant's attorney, Mr. Michael J. Blake on Nov. 8, 2004, a provisional election was made with traverse to prosecute the invention of group I, claims 1-4, 7, 8 and 10. Affirmation of this election must be made

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by applicant in replying to this Office action. It is of note that group II is subject to further restriction based on the value of variable A in the future applications.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, last line, the applicants mention acylating agent IXb. However, the structure of IXb is missing.

In claim 10, the structure of colored acidic triazolylthio compound as well as the formula of hydroxyalkyl compound are missing.

9. Claims 1-4, 7, 8 and 10 are objected as containing non-elected subject matter.

***Allowable Subject Matter***

10. The following is a statement of reasons for the indication of allowable subject matter: The instant compounds of formula II directed to the elected subject matter are

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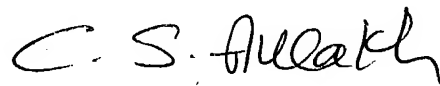
allowable over the prior art since they are neither disclosed nor obvious over the prior art. In the prior art, Weaver (U.S. Patent no. 3,689,501, cited on applicants form 1449) discloses Anthraquinone compounds containing a triazolylthio group which are closely related to the instant compounds when A represents Anthraquinone in the instant compounds of formula II. However, closely related compounds ( see examples 23-144 in table 1 in columns 17-19 ) disclosed by Weaver differ from the instant compounds in having a different Y group attached to the triazolyl group and furthermore, there is no teaching, suggestion or motivation in the prior art to modify the compounds of Weaver to prepare the instant compounds of formula II.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charanjit S. Aulakh  
Primary Examiner  
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